

Remarks

The claims are 1-14. Claims 1 and 13 have been amended to recite that the bioactive substance is fipronil, avermectin, ivermectin, eprinomectin, milbemycin, imidacloprid, phenylpyrazoly, nodulisporic acid, estradiol benzoate, tremplone acetate, noresthisterone, progesterone, macrolide, azalide, or non-steroidal anti-inflammatory drug, as described in the original specification at, for example, page 9, line 31 to page 10, line 3. Imidacloprid is described at, for example, page 19, line 19. New Claim 15 recites ivermectin and eprinomectin, which are in the Examples. Accordingly, the changes are not new matter.

I. Rejections Under 35 USC 102

Claims 13-14 have been rejected under 35 U.S.C. § 102 as allegedly being unpatentable over U.S. Patent No. 5, 447,725 ("Damani"). Applicants respectfully submit that Damani does not describe the present invention as claimed in Claims 1 and 13, as amended. Damani does not disclose the present invention's mixture – particularly utilizing fipronil, avermectin, ivermectin, eprinomectin, milbemycin, imidacloprid, phenylpyrazoly, nodulisporic acid, estradiol benzoate, tremplone acetate, noresthisterone, progesterone, macrolide, azalide, or a non-steroidal anti-inflammatory drug.

Thus, Damani does not anticipate Claims 13 or 14.

Claims 1-4, 7-10, and 12-14 are rejected under 35 U.S.C. § 102 as allegedly being unpatentable over U.S. Patent No. 6,130,200 ("Broadbeck"). Applicants respectfully submit that Broadbeck does not describe the present invention as claimed in Claims 1-4, 7-10, and 12-14, as amended. Broadbeck does not disclose the present invention's mixture – particularly utilizing fipronil, avermectin, ivermectin, eprinomectin, milbemycin, imidacloprid, phenylpyrazoly, nodulisporic acid, estradiol benzoate, tremplone acetate, noresthisterone, progesterone, macrolide, azalide, or a non-steroidal anti-inflammatory drug.

Thus, Broadbeck does not anticipate Claims 1-4, 7-10, and 12-14.

Applicants respectfully submit that the rejections have been overcome and request their withdrawal.

Rejections Under 35 USC 103

The claims have been rejected as allegedly unpatentable over Broadbeck and U.S. Patent No. 5,792,496 ("Tipton") in view of each other.

Applicants respectfully submit that neither describes the present invention's mixture – particularly utilizing fipronil, avermectin, ivermectin, eprinomectin, milbemycin, imidacloprid, phenylpyrazoly, nodulisporic acid, estradiol benzoate, tremplone acetate, noresthisterone, progesterone, macrolide, azalide, or a non-steroidal anti-inflammatory drug. Moreover, the Examiner states without pointing out the motivation (other than using the present invention as a template) that one would modify Broadbeck to optimize the concentrations to a desirable lower level via routine experimentation. Applicants respectfully submit that the standard first requires a showing of motivation, not routine experimentation, to arrive at the applicant's invention. Otherwise, any formulation can be arrived at by routine experimentation and all formulations would be obvious.

Similarly, the Examiner asserts that it would be obvious to modify the Tipton invention to arrive at the optimized solvent mixtures of the present invention. Again, the Examiner has not shown motivation other than the present invention as a template. Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness and request withdrawal of the rejections.

Conclusion

Applicants respectfully submit that the application is in condition for allowance and request a Notice to that effect. If a telephonic discussion would be helpful to further the prosecution, Applicants' attorney can be reached at the telephone number below. Correspondence should continue to be directed to the address below. Any deficiencies in fees should be charged to Deposit Account 13-2755.

Respectfully submitted,

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

MERCK & CO., INC.

By Shu M. Lee Date Aug 6, 2002

Date: August 6, 2002

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